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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,184	06/26/2003	Kazuhito Kojima	21776-00033-US1	1598

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EXAMINER

LIN, SHEW FEN

ART UNIT	PAPER NUMBER
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2166

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,184

Applicant(s)

KOJIMA ET AL.

Examiner

Shew-Fen Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/20/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

- a. This action is responsive to amendment filed on 6/20/2006.
- b. Claims 1 and 7-11 are pending. Claims 2-6 have been cancelled and claims 7-11 have been added. Claims 1 and 9 are independent claims.

Specification/Drawings

In view of the amendment to the specification/drawings, the Examiner withdraws the objections that were given in the previous Office Action.

Response to Amendment and Remarks

Applicant's arguments with respect to claims 1 and 7-11 have been considered but are moot in view of new/old grounds of rejection. Upon further search the Examiner has found the prior art reference of Syeda-Mahmood (US Patent, 5,920,856), in combining with Brown et al. (US Patent 5,913,208), and Belfiore et al. (US Patent 6,038,610). Refer to the corresponding sections of the claim analysis for detail.

In response to applicant's argument on page 9, *a prima facie case of obviousness* is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness. In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

Interpretation of Claims-Broadest Reasonable Interpretation

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541,550-51 (CCPA 1969).

In response to applicant's argument, to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981).

"Reason, suggestion, or motivation to combine two or more prior art references in single invention may come from references themselves, from knowledge of those skilled in art that certain references or disclosures in references are known to be of interest in particular field, or from nature of problem to be solved;" *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.* U.S. Court of Appeals Federal Circuit 37 USPQ2d 1626 Decided February 7, 1996 Nos. 95-1171, -

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"[q]uestion is whether there is something in prior art as whole to suggest desirability, and thus obviousness, of making combination." *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.* U.S. Court of Appeals Federal Circuit 221 USPQ 481 Decided Mar. 21, 1984 No 83-1178.

Regarding Applicant's arguments that Syeda-Mahmood does not teach or suggest limitations "saving metadata pertaining to real data stored in data bases", "metadata pertaining to real data stored in database" and "real data retrieval request is not issued by bypassing the second server". It should be noted that Mehrotra and Thomas teach the above limitations in combination with Syeda-Mahmood as detailed in the previous Office Action. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Based on the amendment of the claims, new prior arts are used to teach the above cited limitation, Please refer to claim analysis for detail.

Please noted the amended claims should comply with 37 CFR 1.121 (see MPEP 714). All amendments filed on or after July 30, 2003 must comply with 37 CFR 1.121 as revised in the notice of final rule making published in the Federal Register on June 30, 2003 at 65 Fed. Reg. 38611.

(B) Markings to Show the Changes:< All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by strike-through (for deleted matter) or underlining (for added matter) with 2 exceptions: (1) for deletion of five or fewer consecutive characters, double brackets may be used (e.g., [[eroor]]); (2) if strike-through cannot be easily perceived (e.g., deletion of number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets,

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however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g. ~~number 4 as~~ number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" or "withdrawn" will include markings.

> Any claims added by amendment must be indicated as "new" and the text of the claim must not be underlined.<

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syeda-Mahmood (US Patent, 5,920,856) in view of Brown et al. (US Patent 5,913,208, hereinafter referred as Brown), and Belfiore et al. (US Patent 6,038,610, hereinafter referred as Belfiore).

As to claims 1 and 9, Syeda-Mahmood discloses a system with system/method of data retrieval by a user from a distributed database (distributed database used by multiple users, column 1, lines 6-9, column 4, lines 1-2), comprising:

saving metadata pertaining to real data stored in databases distributed on a network in first servers distributed on said network associated with each of said databases (web site database reads on first servers, Figure 1, item 7, column 5, lines 15-16, column 6, lines 10-13);

collecting metadata saved in said first servers and storing said metadata in a metadata database of a second server without storing the real data represented by said metadata (store metadata, indexing for database, in metadata server separating from multimedia database, Figure 1, item 2, column 4, lines 6-9, lines 17-21, column 5, lines 15-16);

extracting metadata that matches a user retrieval request from a user terminal by searching metadata stored in said metadata database (query meta-database, Figure 2, column 4, lines 23-26, column 5, lines 30-32, column 6, lines 49-51) and transmitting a retrieval result (mapping query to index, column 6, lines 66-67) including information of a location of the first server saving the metadata that matches said user retrieval request (list of database sites, for example, URL, column 2, lines 49-51, column 7, lines 3-4), to said user terminal (Figure 2, item 6, column 6, lines 30-33) ;

inputting a real data retrieval condition for the database on the basis of the retrieval result of the metadata transmitted to said user terminal (select from list of database that matched query and fed back to client for further filtering, Figure 3, item 19, column 5, lines 24-27, column 9, lines 32-33);

issuing a real data retrieval condition from said user terminal to the first server on the basis of said information of a location of a first server (transform query result form meta-database into forms for respective database, Figure 3, column 7, lines 14-16), wherein said real data retrieval condition is issued to said first server (retrieve data from multimedia database, first server, Figure 3, column 7, lines 17-18); by bypassing said second server and

retrieving, by the first server, the real data from the corresponding after converting said real data retrieval condition into a format which is concordant with the database (pose the query in the acceptable form of the target database and forward result to the user, Figure 1, column 7, lines 17-18, column 9, lines 21-38).

Syeda-Mahmood does not explicitly disclose saving metadata pertaining to real data stored in databases in first servers associated with said databases. Belfiore discloses saving metadata (sitemap, a data block on the server that hold the index information about the document on the server, column 1, lines 31-37) pertaining to real data stored in first servers associated with each of said databases (column 2, lines 66-67) and sitemap files can be extracted by web crawler to build a index to the site (Figure 12, column 12, lines 57-67).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Syeda-Mahmood's disclosure to store metadata associated with data in a

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same location as taught by Belfiore for the purpose of providing site information for different applications; client computer, web search engine (Figures 11-12, column 1, lines 56-59, Belfiore). The skilled artisan would have been motivated to improve the invention of Syeda-Mahmood per the above such that metadata is created locally and available to different users.

Syeda-Mahmood does not explicitly disclose that search agent/engine and meta database are located in different server and the real data retrieval is issued by bypassing the second server. Brown discloses that index server (metadata server) located separately with search agent/server (Figure 1, item 170, 175, 180, column 5, lines 53-60). Queries are entered at client (Figure 1, item 190, column 6, lines 1-9, Figure 3A, item 310) directing to web server (Figure 1, item 170), web server accesses index server (metadata server, Figure 1, item 180, column 4, lines 61-63) and forward retrieval result to client with database location (hit list, Figure 3B, item 350). The user selects the documents from hit list and retrieve those document without go through index server (column 1, lines 22-26, column 2, lines 57-61).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Syeda-Mahmood's disclosure to store metadata as a separate server as taught by Brown for the purpose of providing access to index (metadata) for computers on the network and retrieve real data without go through index server (Figure 1, column 5, lines 15-22, Brown). The skilled artisan would have been motivated to improve the invention of Syeda-Mahmood per the above such that metadata can be easily accessed in a local/wide area network or World Wide Web.

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As to claims 7 and 10, Syeda-Mahmood discloses wherein, when the metadata which is saved in the first servers and pertaining to the real data has been updated, said metadata is stored in said metadata database of said second server without storing the real data pertaining to said metadata (updated the metadata, “templates” of database and relay to the meta-database, column 6, lines 13-15).

As to claims 8 and 11, Syeda-Mahmood discloses wherein the metadata which is saved in the first server and pertaining to the real data is stored in said metadata database of said second server without storing the real data pertaining to said metadata at a predetermined time interval (periodically updated the metadata, “templates” of database and relay to the meta-database, column 6, lines 13-15).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shew-Fen Lin
Patent Examiner



Art Unit 2166
September 1, 2006



**MOHAMMAD ALI
PRIMARY EXAMINER**